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09/829,524	04/09/2001	Steven J. Smith	00694001	8436

23910 7590 04/08/2005	EXAMINER
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2121	

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DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/829,524	SMITH, STEVEN J.
	Examiner	Art Unit	
	Thomas K Pham	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 January 2005*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 January 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Response to Amendment

1.   This action is in response to request for re-consideration filed on ...

2.   New claims 21-42 filed by the applicant have been entered.

3.   Applicant's amendment, with respect to the addition of claims 21-42 and the new issue of

claims 1-20, necessitated the new ground(s) of rejection presented in this Office action.

Quotations of U.S. Code Title 35

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim Rejections - 35 USC § 103

6.   Claims 1-7, 9-17, 19-27 and 30-40 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent No. 6,343,327 ("Daniels") in view of U.S. Patent No. 5,937,162

("Funk").

Regarding claims 1, 11, 21, 22 and 23

Daniels teaches transmitting electronic messages comprising: generating a plurality of lists of

mailing addresses, each of said lists containing a portion of a primary mailing list (col. 5 lines

48-55, "electronic inserter 110 ... on the same network"); allocating a plurality of independent

electronic mail delivery resources (col. 4 lines 14-25, "The separate electronic mail pieces ... via

security module 114"); providing separate ones of the plurality of lists or groups of the plurality

of lists to the plurality of electronic mail delivery resources (col. 4 lines 14-25); wherein each

one of the plurality of electronic mail delivery resources can creating electronic mail messages

based on the lists and on generic message content data (col. 6 lines 30-44, "The job setup process

... for each electronic delivery mechanism"); and transmitting the electronic mail messages with

the plurality of electronic mail delivery resources to addressees contained in the lists sent to the

plurality of electronic mail delivery resources (col. 2 lines 14-20, "A message router delivers ...

another electronic delivery mechanism"). Daniels does not teach the plurality of electronic mail

delivery resources are capable of processing separate ones of the plurality of lists in parallel.

However, Funk teaches the e-mail messages are process in parallel by multiple transmission

queues (see abstract) for the purpose of simultaneously process the e-mail transmission within a

selecting time period. Therefore, it would have been obvious to one of ordinary skill in the art at

the time of the invention to incorporate the parallel e-mail transmissions of Funk with the e-mail

system of Daniels because it would provide for the purpose of simultaneously process the e-mail

transmission within a selecting time period.

Regarding claims 2 and 12

Daniels teaches initiating a primary electronic mail transmission process in a first computer,

wherein the first computer is capable of communicating with the plurality of electronic mail

delivery resources (FIG. 1 shows electronic inserter 110 process the electronic mails batch and

communicates to the delivery resources (web browser, e-mail, pager, fax and printer).

Regarding claims 3 and 13

Daniels teaches the first computer is a database server containing the lists of mailing addresses

(col. 3 lines 26-31, "A user at a sender's ... document in the printstream").

Regarding claims 4 and 14

Daniels teaches verifying that an electronic mail message has been sent to each addressee set

forth in the lists of mailing addresses (col. 4 lines 26-33, "If the electronic mail ... by physical

means").

Regarding claims 5 and 15

Daniels teaches partitioning a primary mailing list into the plurality of lists of mailing addresses

(col. 5 lines 48-55, "electronic inserter 110 ... on the same network").

Regarding claims 6 and 16

Funk teaches designating at least one bounced mail resource capable of receiving any bounced

messages or replies (col. 15 lines 4-7); and wherein the at least one bounced mail resource is

capable of providing delivery failure information in a compact form (col. 15 lines 14-20).

Regarding claims 7 and 17

Daniels teaches reviewing mail transmission progress information generated by the electronic

mail delivery resources (col. 7 lines 21-23, "Status for each electronic ... in the interlock file

400").

Regarding claims 9 and 19

Funk teaches automatically updating the primary mailing list based on returned mail information

(col. 15 lines 21-25).

Regarding claims 10 and 20

Daniels teaches primary mailing list is stored at a location separated from the plurality of

electronic mail delivery resources (col. 4 lines 14-25, "The separate electronic mail ... via

security module 114").

Regarding claim 24

Daniels teaches a system for transmitting electronic messages comprising: a plurality of lists of

mailing addresses, each of said lists containing a portion of a primary mailing list (col. 5 lines

48-55, "electronic inserter 110 ... on the same network"; a plurality of electronic mail delivery

resources each capable of receiving one of the plurality of lists (col. 4 lines 14-25, "The separate

electronic mail pieces ... via security module 114") to perform: generating electronic mail

messages from generic message content data (col. 6 lines 30-44, "The job setup process ... for

each electronic delivery mechanism"); and transmitting the generated electronic mail messages

to addresses in one of the plurality of lists (col. 2 lines 14-20, "A message router delivers ...

another electronic delivery mechanism"). Daniels does not teach each of the electronic mail

resources capable of working in parallel; and wherein the number of electronic mail delivery

resources is estimated to satisfy a target delivery time. However, Funk teaches the e-mail

messages are process in parallel by multiple transmission queues/processors (see abstract); and

the number of queues/processors (electronic mail delivery resources) is estimated to satisfy a

target delivery time (col. 13 lines 48-53, "The out-bound e-mail processing ... added queues or

processors") for the purpose of simultaneously process the e-mail transmission within a selecting

time period. Therefore, it would have been obvious to one of ordinary skill in the art at the time

of the invention to incorporate the parallel e-mail transmissions of Funk with the e-mail system

of Daniels because it would provide for the purpose of simultaneously process the e-mail

transmission within a selecting time period.

Regarding claim 25

Funk teaches the number of electronic mail delivery resources is based on the number of

addressees in the primary mailing list (col. 13 line 63 to col. 14 line 2).

Regarding claim 26

Funk teaches one or more bounced mail resources capable of modifying the primary address list

based on failed delivery of electronic mail messages (col. 15 lines 21-25).

Regarding claim 27

Funk teaches the plurality of lists of mailing addresses is determined based on recognizing that a

number of members of the primary address list reside in a common network (col. 3 lines 63-67).

Regarding claim 30

Funk teaches one or more request processing resources capable of processing requests for

changes to the primary mailing list (col. 15 lines 10-20).

Regarding claims 31 and 39

Daniels and Funk teach an independent electronic mail delivery resource in the plurality of

independent electronic mail delivery resources can be one of: a mail transfer agent, an

independent computing device, and a process (see FIG. 1 of Daniels and FIG. 9 of Funk).

Regarding claims 32 and 40

Funk teaches the number of electronic mail transmission resources is estimated to satisfy a target

delivery time (col. 13 lines 48-53, "The out-bound e-mail processing ... added queues or

processors").

Regarding claim 33

Funk teaches the allocating can be delayed until the plurality of independent electronic mail

delivery resources are available (col. 14 lines 34-42).

Regarding claim 34

Funk teaches transmitting the generic message content data to at least one of the plurality of

electronic mail delivery resources (col. 13 lines 33-36).

Regarding claims 35 and 37

Funk teaches the plurality of electronic mail delivery resources is located on a first local network

(FIG. 7 shows a first local network includes the e-mail delivery system 104); and wherein the

lists and the generic message content data are transmitted from a second local network to the first

local network (FIG. 7 shows the generic messages are transmitted from at least one second local

network 702 a-d).

Regarding claims 36 and 38

Funk teaches designating at least one request processing resource capable of processing requests

for changes to the primary mailing list (col. 15 lines 21-25); and wherein the at least one request

processing resource is capable of providing subscription change information in a compact form

(col. 15 lines 14-20).

7.   Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniels

in view of Funk and further in view of U.S. Patent No. 5,835,762 ("Gans").

Regarding claim 41

Daniels teaches transmitting electronic messages comprising the steps of: allocating a plurality of

independent electronic mail delivery resources (col. 4 lines 14-25, "The separate electronic mail

pieces ... via security module 114"); creating electronic mail messages based on the lists and on

generic message content data (col. 6 lines 30-44, "The job setup process ... for each electronic

delivery mechanism"); transmitting the electronic mail messages with the plurality of electronic

mail delivery resources to addressees contained in the lists sent to the plurality of electronic mail

delivery resources (col. 2 lines 14-20, "A message router delivers ... another electronic delivery

mechanism"). Daniels does not teach a fault-tolerant method for the plurality of electronic mail

delivery resources that are capable of processing separate ones of the plurality of lists in parallel

and restarting any stalled or failed electronic mail delivery resource wherein the restarting is

from a checkpoint. However, Gans teaches the e-mail messages are process in parallel by

multiple transmission queues (see abstract) and a guardian process (checkpoint system) capable

of examining system information periodically to initiate, restart, or stop one or more resources

(col. 8 lines 26-30, "the guardian process retains ... stop one or more processes") for the purpose

of identifying and assisting the process in determining how to proceed. Therefore, it would have

been obvious to one of ordinary skill in the art at the time of the invention to incorporate the

parallel e-mailing system of Gans with the e-mail system of Daniels because it would provide for

the purpose of identifying and assisting the process in determining how to proceed.

Regarding claim 42

Daniel teachesn verifying that an electronic mail message has been sent to each addressee set

forth in the lists of mailing addresses (col. 4 lines 26-34).

8.   Claims 8, 18, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Daniels in view of Funk and further in view of U.S. Patent No. 5,835,762 ("Gans").

Regarding claims 8 and 18

Daniels and Funk do not teach restarting any stalled or failed electronic mail delivery resource

identified in the viewing and wherein the restarting is from a checkpoint. However, Gans teaches

a system for processing electronic mail in parallel including a guardian process capable of

examining system information periodically to initiate, restart, or stop one or more resources (col.

8 lines 26-30, "the guardian process retains ... stop one or more processes") for the purpose of

identifying and assisting the process in determining how to proceed. Therefore, it would have

been obvious to one of ordinary skill in the art at the time of the invention to incorporate the

parallel e-mailing system of Gans with the e-mail systems of Daniels and Funk because it would

provide for the purpose of identifying and assisting the process in determining how to proceed.

Regarding claim 28

Gans teaches an electronic mail delivery resource in the plurality of electronic mail delivery

resources is automatically restarted if it stalls or fails (col. 8 lines 26-30, "the guardian process

retains ... stop one or more processes").

Regarding claim 29

Gans teaches a guardian process (checkpoint system) capable of restarting any stalled or failed

electronic mail delivery resource in the plurality of electronic mail delivery resources wherein

the restarting is from a checkpoint (col. 8 lines 26-30, "the guardian process retains ... stop one

or more processes").

Response to Arguments

In the remark the applicant argues that:

I) Daniels fails to disclose partitioning primary list into separate lists of mailing addresses.

II) Daniels discloses a single electronic mail delivery resource.

III) Daniels does not disclose determining a number of resources that can operate in parallel.

IV) Daniels does not disclose receiving bounced messages or replies.

In response to applicant's argument,

I) It is noted that prior art Daniels (USPN 6,343,327) teaches electronic mail pieces which can be

deliver electronically via a web servers, electronic mail addresses, pages, facsimile and/or

network printer (see col. 4 lines 15-18). The system is configured to use the facsimile, pager

and/or network printer for informing the mail recipient after an electronic mail was sent via a

web server and/or electronic mail address (see col. 4 lines 18-23). Thus, it should be noted that

the mail pieces are inherently include e-mail addresses in order for the system to sent the mail

electronically to the intended recipients whether to a web server and/or to an e-mail server.

Furthermore, FIG. 4 shows the electronic inserter 110 splits the printstream 224 (primary list) out

into a plurality of packages (lists) of electronic email pieces (see col. 5 lines 48-52). Therefore, it

is clear that Daniels is partitioning the primary list (printstream 224) into separates lists

(packages) of mailing addresses for delivery by the mailing system.

II) It is noted that Daniels teaches a plurality electronic mail pieces delivery mechanisms as

shown in FIG. 1. In addition, column 4 lines 14-25 discloses the electronic mail pieces delivery

mechanisms can be a web server, an electronic mail address, a pager, a fax machine, or a

network printer in which a message router 112 is used to allocate electronic mail pieces to each

of the delivery mechanisms individually based on the addressing information. Therefore, it is

clear the delivery mechanisms are the electronic mail delivery resources for processing the

electronic mail based the addressing information as claimed.

III) Funk (USPN 5,937,162) teaches determining the number of queues/processors (resources)

needed to process e-mail messages to satisfy a target delivery time (see col. 13 lines 48-53).

Therefore, the limitations are met by Funk.

IV) Again, Funk teaches receiving bounced e-mail or replies by an automatic bounce e-mail

handling procedure (see col. 15 lines 4-7 and col. 15 lines 10-13). Therefore, the limitations are

met by Funk.

Conclusion

9.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the examiner should

be directed to examiner *Thomas Pham*; whose telephone number is (571) 272-3689, Monday to Thursday

from 6:30 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (571) 272-3687.

Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
applications is available through Private PAIR only. For more information about the PAIR
system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private
PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas Pham
Patent Examiner

TP

March 30, 2005

Anthony Knight
Supervisory Patent Examiner
Group 3600